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In The

# Supreme Court of the United States

October Term, 1995

VORNADO AIR CIRCULATION SYSTEMS, INC.,

*Petitioner,*

v.

DURACRAFT CORPORATION,

*Respondent.*

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Tenth Circuit

## MOTION FOR LEAVE TO FILE BRIEF AS AMICI CURIAE AND BRIEF OF THOMAS & BETTS CORPORATION AND THOMAS & BETTS HOLDINGS, INC. IN SUPPORT OF THE PETITION

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## MOTION OF THOMAS & BETTS CORPORATION AND THOMAS & BETTS HOLDINGS, INC. FOR LEAVE TO FILE BRIEF AS AMICI CURIAE IN SUPPORT OF THE PETITION

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Pursuant to Rule 37.2 of the Rules of this Court, Thomas & Betts Corporation and Thomas & Betts Holdings, Inc. (collectively "T&B") respectfully move this Court for leave to file the attached brief as *amici curiae* in support of the petition for a writ of certiorari. The written consent of petitioner has been filed with the Clerk. Counsel for respondent has withheld consent.

T&B's interest in this case arises from the fact that it is plaintiff-appellee in *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), *reh'g denied and suggestion for reh'g en banc declined*, No. 94-3911 (7th Cir., Oct. 23, 1995), in which the decision of the Tenth Circuit for which review is now sought was discussed at length and carried further. While the Seventh Circuit's discussion of the subject Tenth Circuit decision was dicta in *Thomas & Betts*, it may nonetheless severely impact T&B in subsequent proceedings as a ground for denying T&B trade dress protection in the ongoing *Thomas & Betts* litigation.

T&B's amicus brief will be of value to the Supreme Court because it brings to the Court's attention two recent court of appeals decisions which were not addressed in the petition: the Seventh Circuit's September 14, 1995 decision in *Thomas & Betts*, as well as the October 10, 1995 decision in *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995). The *Thomas & Betts* and

*Elmer* decisions further complicate the conflicts and confusion in the law on the very issue addressed in the present petition.

T&B's amicus brief also brings to the Court's attention a unique situation among the courts of appeal which diminishes the likelihood that those courts will satisfactorily resolve the conflict among themselves without Supreme Court guidance. As explained in T&B's amicus brief, the issue raised by the petition involves the relationship between the patent laws and the Lanham Act. The regional circuits (such as the Tenth Circuit, from which the present case arises) have had no recent experience in core patent law issues, inasmuch as exclusive jurisdiction over patent infringement actions has been vested in the Federal Circuit since 1982. On the other hand, the Federal Circuit, which has extensive experience in patent matters, defers to the discernible law of the regional circuits on issues such as trade dress when it decides a case that includes trade dress infringement issues. As a consequence of this, no coherent approach to the issue for which review is here sought is likely to emerge from the courts of appeal, a situation which undermines Congress' intent in establishing the Federal Circuit, *i.e.*, uniformity and certainty in the patent law area.

T&B's amicus brief also brings to the Supreme Court's attention the potentially far-reaching effects of the Tenth Circuit's decision on intellectual property owners, especially when considered with the subsequent *Thomas & Betts* decision, in which a separate petition for certiorari will be filed shortly. In *Thomas & Betts* (based upon separate dicta in the *Vornado* decision for which

review is here sought), the Seventh Circuit imposed a new and onerous burden on trade dress owners in connection with establishing "secondary meaning" in product configurations under the Lanham Act. The *Vornado* and *Thomas & Betts* decisions are closely related and, taken together, effectively cripple the ability of innovators to establish and vindicate trade dress rights in product configurations under the Lanham Act. As T&B explains in its amicus brief, the special rules and restrictions erected by the Tenth Circuit – and now the Seventh Circuit – run counter to the Supreme Court's most recent decisions in the trade dress area.

Accordingly, T&B seeks to submit this brief as *amici curiae* to assist the Supreme Court in evaluating the public importance and the practical consequences of utilizing patents as an absolute bar against product configuration trade dress rights under the Lanham Act. For this reason, T&B requests that its motion for leave to file the accompanying brief be granted.

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## BRIEF AMICUS CURIAE OF THOMAS & BETTS CORPORATION AND THOMAS & BETTS HOLDINGS, INC. IN SUPPORT OF THE PETITION

Thomas & Betts Corporation and Thomas & Betts Holdings, Inc. (collectively "T&B") respectfully submit this brief as *amici curiae* in support of the petition for a writ of certiorari filed by Vornado Air Circulation Systems, Inc. ("Vornado").

## INTEREST OF THE AMICI CURIAE

As explained more fully in the attached motion for leave to file this brief, T&B's interest in this case arises from the fact that T&B is plaintiff-appellee in *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), *reh'g denied and suggestion for reh'g en banc declined*, No. 94-3911 (7th Cir., Oct. 23, 1995). In *Thomas & Betts*, the Seventh Circuit relied upon the decision of the Tenth Circuit in this case in its discussion of the relationship between patents and trade dress law.

## ARGUMENT

### 1. Preliminary Statement

The Tenth Circuit's decision is wrong. It purports to resolve a conflict between the patent laws and the Lanham Act which does not exist, since patent rights and trade dress rights are manifestly different from each other. But even assuming that a conflict does exist, it is *already* being resolved by the functionality doctrine (sometimes referred to as the "competitive need" test). Further, the Tenth Circuit's view that a feature should be barred from trade dress protection if the feature is but one element of a combination claimed in a patent is based on a faulty premise which misapprehends the concept of a patent claim directed to a *combination* of elements. It is

black letter law that *all elements* of a combination patent claim are material and essential, such that to establish patent infringement, a patentee must show that *all elements* or their substantial equivalents are present.[1] Thus, the presence of the spiral grill as one of several elements in Vornado's combination patent claims never did and never could give Vornado any exclusive patent-based rights in the spiral grill *per se*. Vornado should not have been denied trade dress protection based upon its patent.

In any event, whether or not the Supreme Court ultimately agrees with the petitioner and T&B that the Tenth Circuit has erred, Vornado's petition should be granted because:

- As discussed below in Section 2, the conflict among the circuits discussed in Vornado's petition has now been compounded by *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), *reh'g denied and suggestion for reh'g en banc declined*, No. 94-3911 (7th Cir., Oct. 23, 1995), which indicates that the *Vornado* decision was "misguided" and did not go far enough. The *Thomas & Betts* decision suggests that features which are merely *disclosed* in a patent (even if not claimed) may be sufficiently important to be barred from trade dress protection under the *Vornado* rationale, even if such features are distinctive and non-functional. Additionally, the law has now been confused even further by *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995). *Elmer*, applying the trade dress law of the Eleventh Circuit and not mentioning either *Vornado* or *Thomas & Betts*, states that where trade dress rights are "essentially coextensive" with or broader than patent claims, they may frustrate the patent laws and, as such, are invalid; however, if the trade dress

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[1] *See, e.g., Lemelson v. United States*, 752 F.2d 1538, 1551 (Fed. Cir. 1984).

rights are defined more narrowly, the situation might be different. The three approaches are substantially different and would lead to significantly different results in a given case.

- As discussed below in Section 3, it is extremely unlikely that the courts of appeal will ever develop a coherent approach to the relationship between patents and trade dress without guidance from the Supreme Court. Because the Federal Circuit has had exclusive jurisdiction over patent infringement actions for over a decade, it is the only court of appeals with significant experience in the patent field. However, since the Federal Circuit applies the trade dress law of the regional circuits in appeals from district courts which include both patent and trade dress infringement claims,[2] even the Federal Circuit will not develop a coherent approach to the relationship between patents and trade dress. This unique fractionalization of subject matter jurisdiction will lead to increased confusion, rather than a coherent approach that will attract a consensus among the circuits. Allowing these conflicts to continue undermines the congressional policy of encouraging uniformity in the patent law area which led to the creation of the Federal Circuit.

- As discussed below in Section 4, the implications of *Vornado* (as expanded by *Thomas & Betts*) are enormous. Patent claims virtually always involve combinations of old elements or features, each of which are separately unpatentable. If *Vornado* is allowed to stand, any feature which is ever identified in a patent claim in an effort to define a patentable combination invention will likely be forever barred from protection under the Lanham Act. And if the Seventh Circuit view that *Vornado* did not go far enough becomes law, then virtually no product feature which is ever mentioned in any

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[2] *See, e.g., Elmer*, 67 F.3d at 1578.

way in a patent will be eligible for trade dress protection, even if it is distinctive and non-functional. This view threatens distinctive and non-functional features that were disclosed in patents that expired years ago (as in *Thomas & Betts*) and patents still in force (as in *Vornado*), and would seem to even jeopardize existing product configuration trade dress rights where the owner may yet obtain a patent in the future. If *Vornado* is not reversed, innovators will be deterred from seeking patent protection (or from disclosing any more information than is absolutely necessary to obtain a patent), thus depriving the public of the benefits of full disclosure of inventions. Other innovators will be deterred from establishing and building up trade dress that assists the public in selecting and distinguishing competitive products.

## 2. The Conflict Among The Circuits Has Been Compounded By The Post-*Vornado* Decisions In *Thomas & Betts* and *Elmer*

Vornado's petition accurately describes how the Tenth Circuit's decision in *Vornado* conflicts with decisions in the Sixth, Seventh and Ninth Circuits. Prior to *Vornado*, which holds that the patent and trade dress laws conflict and that functionality is an "incomplete answer" to the conflict, several courts – including the Seventh Circuit – had expressed the view that the patent and trade dress laws *do not* conflict and that the functionality doctrine *does* resolve any perceived conflict.[3] The later decisions in *Thomas & Betts* and *Elmer* have now thrown the law relating to the relationship between patents and trade dress into even greater confusion.

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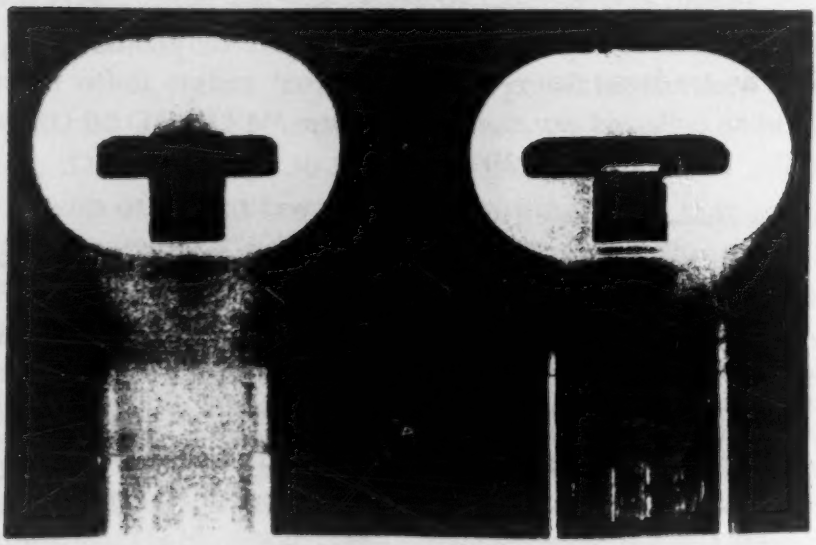
[3] *See, e.g., W.T. Rogers Co. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985); *Koehler Co. v. Moen, Inc.*, 12 F.3d 632, 642 (7th Cir. 1993); *Mechanical Plastics Corp. v. Titan Technologies, Inc.*, 823 F. Supp. 1137, 1144 (S.D.N.Y. 1993).

**a. *Thomas & Betts***

T&B is a manufacturer of "cable ties", *i.e.*, plastic straps which can bundle groups of cables together by inserting one end through a "head" at the opposite end. Since 1962, T&B has been selling a particular line of cable ties having a head with a distinctive oval shape. Between 1965 and 1982, T&B owned a utility patent which covered certain mechanical features of this T&B cable tie. While the specification of T&B's patent disclosed the oval-shaped head, the claims of the patent made no reference to it.

In 1994, Panduit Corp. ("Panduit") introduced a cable tie which substantially duplicated T&B's cable tie, including the oval-shaped head. T&B filed suit in the United States District Court for the Northern District of Illinois alleging, *inter alia*, unfair competition under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). The following photograph shows the T&B and Panduit cable ties side by side (the T&B tie is on the right):



On December 14, 1994, the district court granted T&B's motion for preliminary injunction.[4] *Thomas & Betts Corp. v. Panduit Corp.*, 34 U.S.P.Q.2d (BNA) 1545 (N.D. Ill. 1994). It found that the trade dress of T&B's cable ties had acquired secondary meaning, *id.* at 1555-57, and that Panduit's marketing of its competitive cable tie was likely to cause confusion, *id.* at 1557-58. The district court also held that Panduit's attempt to prove functionality, based in large measure on the existence of T&B's expired utility patent, had failed. *Id.* at 1558-61.[5]

Panduit sought a stay of the injunction before the Seventh Circuit. On December 23, 1994, a panel of the Seventh Circuit denied the stay, stating:

> Panduit's theory is that when the patent expired the entire product fell into the public domain and became freely copyable. That considerably overstates matters. The patented portions of the product entered the public domain, but "the product" did not. Panduit does not contend, for example, that it could copy the cable tie to the last detail, including the Thomas & Betts logo and similar identifying marks. Non-functional elements of the product's design can serve a role similar to logos and therefore may be protected as trademarks.

*Thomas & Betts Corp. v. Panduit Corp.*, 34 U.S.P.Q.2d (BNA) 1607, 1608 (7th Cir. 1994).

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[4] A magistrate judge presided in the district court by consent of the parties. *See* 28 U.S.C. § 636(c).

[5] The Supreme Court has explained that a product feature is functional if essential to the use or purpose of the article, or if it affects cost or quality, *i.e.*, exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage. *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300, 1304 (1995); *see also Vornado*, 58 F.3d at 1507 (Pet. App. 26a) (functionality described in terms of "competitive need").

On September 14, 1995, a different panel of the Seventh Circuit reversed the district court's decision. The *Thomas & Betts* decision began with a lengthy discussion of what was described as the federal "right to copy" pursuant to "the penumbra of the patent laws", which the Seventh Circuit gleaned from earlier decisions of this Court. 65 F.3d at 657-58, citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156-57 (1989), *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 120 (1938), and *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896).

By way of background, the genesis of the purported "right to copy" arising from the expiration of a patent is generally traced to *Singer*. Central to that decision was the belief that upon expiration of a patent, "the right to make the thing covered by the patent becomes public property." 163 U.S. at 185. But what is "the thing covered by the patent" is the combination of elements that is specifically claimed. Upon expiration, the statutory patent right to exclude others from making, using or selling that claimed combination simply ends. *See* 35 U.S.C. § 154 (1952). As noted by the Seventh Circuit stay panel, the suggestion that the expiration of a patent permits violation of other rights "considerably overstates matters." 34 U.S.P.Q.2d at 1608. As stated in *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964), "We know of no provision of patent law, statutory or otherwise, that guarantees to anyone an absolute right to copy the subject matter of any expired patent." For example, if The Coca-Cola Company obtained a patent claiming a new plastic composition useful in making bottles, and if the patent disclosed in its specification the famous fluted COCA-COLA bottle as a product made with such plastic, the expiration of the patent on the new *plastic* should not impair the established trade dress rights in the *bottle*.

Panduit had contended in *Thomas & Betts* that even if a product's feature has acquired secondary meaning and is non-functional, it still cannot be protected as trade dress if it was disclosed in an expired patent. The Seventh Circuit indicated that *Vornado*, decided two months earlier, "comes close to adopting Panduit's proposed rule." *Thomas & Betts*, 65 F.3d at 659. The Seventh Circuit recited how *Vornado* had held that "where a disputed product configuration is part of a claim in a utility patent, and the configuration is a described, significant inventive aspect of the invention, see 35 U.S.C. Section 112, so that without it the invention could not fairly be said to be the same invention, patent law prevents its protection as trade dress, even if the configuration is nonfunctional." *Id.*, quoting *Vornado Air Circulation Systs., Inc. v. Duracraft Corp.*, 53 F.3d 1498, 1510 (10th Cir. 1995) (Pet. App. 35a-36a).

The Seventh Circuit then stated that *Thomas & Betts* was distinguishable from *Vornado*, but that it was not clear to the Seventh Circuit that the differences dictate a different result. In particular, the Seventh Circuit acknowledged that the oval shape of the cable tie head was not claimed in T&B's patent, while the spiral grill was a required element in the patent claims at issue in *Vornado*. *Thomas & Betts*, 65 F.3d at 659-60. However, according to the Seventh Circuit, whether or not a feature is claimed "is not necessarily . . . a good indicator of its relative importance to the invention as a whole", and that the Tenth Circuit's focus on what is or is not claimed was fundamentally "misguided". *Id.* at 660. According to the Seventh Circuit, while the claims define what the patentee receives in terms of the right to exclude competitors, the public receives "the entire invention" which is "primarily" disclosed in the patent specifications which are required by 35 U.S.C. § 112 to fully, clearly and

concisely describe the invention. *Id.* The Seventh Circuit thus suggested that the appearance of a product feature in the *specification* of a patent should bar trade dress rights under the Lanham Act, even if the feature is distinctive and non-functional.[6]

The reasoning of the Seventh Circuit on the relationship between patents and trade dress is erroneous. That a feature appears in a patent *specification* (but not a claim) is even less of a reason to bar trade dress rights out of a concern that trade dress rights could create a perpetual right to exclude. The *claims* are the sole measure of the patent grant, and the patent grant confers no monopoly over features which are not claimed. *Aro Mfg. Co. v.*

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[6] After this lengthy discussion of the relationship between patents and trade dress, the Seventh Circuit simply stated that it need not pass on the correctness of *Vornado*, as it concluded that T&B had not established that its trade dress had acquired secondary meaning. *Thomas & Betts*, 65 F.3d at 660-64. Citing separate dicta in *Vornado* (58 F.3d at 1502 n.7; Pet. App. 11a), the Seventh Circuit held that T&B's evidence did not support a finding of secondary meaning because the district court had improperly defined secondary meaning "as an association in the mind of the consumer between the trade dress of a product and a particular source," *citing* 34 U.S.P.Q.2d at 1555, and instead should have applied a "more stringent" standard, *i.e.*, "that in the minds of consumers the primary significance of the oval head is to identify [T&B's cable tie] as a T&B product" – a standard that was said to be mandated by four Supreme Court decisions. 65 F.3d at 661 n.8, citing *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 120 (1938); *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300, 1303 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, 2756 n.4 (1992); and *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982). Because T&B believes that the Seventh Circuit's decision on the secondary meaning issue is clearly incorrect and conflicts with decisions of other circuits, T&B will shortly be filing a petition for certiorari to seek review of that decision.

*Convertible Top Replacement Co.*, 365 U.S. 336, 339-40 (1961). Moreover, the Seventh Circuit (like the Tenth Circuit in *Vornado*) failed to appreciate that the functionality doctrine fully protects the ability of others to compete effectively *without* destroying the good will of the trade dress owner and *without* sanctioning confusion in the marketplace.

b. *Elmer*

The October 10, 1995 decision in *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995), adds further to the confusion and disarray on this issue. In *Elmer*, the Federal Circuit (applying the law of the Eleventh Circuit)[7] stated that enforcing the trade dress rights asserted by the plaintiff, which were "essentially coextensive with, and in fact broader than" the claims of the plaintiff's patent, would frustrate the right of competitors to practice the patented invention after expiration, but that defining the trade dress more narrowly might avoid this concern. 67 F.3d at 1580.

*Elmer* thus adds to the conflict and confusion as to the extent to which patents may bar trade dress rights under the Lanham Act. But *Elmer*'s fundamental premise is wrong. The Federal Circuit's predecessor court explained in *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964), why patent rights and trademark rights are different, and why patent and trademark rights can never "extend" one another:

> [Trademark rights] exist independently of [the patent monopoly], under different law and for

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[7] *Elmer*, 67 F.3d at 1578 ("Because trade dress issues are not unique to the exclusive jurisdiction of the Federal Circuit, we defer to the law of the regional circuit in which the district court sits"). *See* Section 3, *infra*.

> different reasons. The termination of either has no legal effect on the continuance of the other. When the patent monopoly ends, it ends. The trademark rights do not extend it. We know of no provision of patent law, statutory or otherwise, that guarantees to anyone an absolute right to copy the subject matter of any expired patent. *Patent expiration is nothing more than the cessation of the patentee's right to exclude held under the patent law.* Conversely, trademarks conceivably could end through non use during the life of a patent. We doubt it would be argued that the patent rights should also expire so as not to "extend" them.

328 F.2d at 930 (emphasis added). *Elmer*, like *Vornado* and *Thomas & Betts*, also failed to appreciate the role of the functionality doctrine in resolving any "conflict" between the patent laws and the Lanham Act.

### c. The Differences Between The Circuits Are Profound

Three circuits have now accepted the erroneous premise that patents may absolutely bar federal trade dress rights under the Lanham Act, but have reached widely disparate views on how this absolute bar should be applied. The Tenth Circuit in *Vornado* held that if an asserted trade dress feature comprises even one element of a combination patent claim, the feature will likely be ineligible for trade dress protection. In contrast, the Federal Circuit in *Elmer* (applying Eleventh Circuit law) compared the asserted trade dress to the patent claims as a whole, and perceived a problem only when the description of the trade dress appeared broader than the patent's broadest claim. And *Thomas & Betts* indicated that *Vornado* did not go far enough, suggesting that if a feature

was merely disclosed in a patent specification, it ought not be susceptible to trade dress protection.

*Thomas & Betts* also adds fuel to the debate over whether the functionality doctrine provides a solution to such "conflict". As mentioned above, prior to *Vornado*, several courts had expressly said that this was the case, including the Seventh Circuit. *Vornado* reached the opposite conclusion, describing functionality as an "incomplete answer" to the conflict it perceived.[8] 58 F.3d at 1506 (Pet. App. 24a). Although *Thomas & Betts* did not explicitly discuss whether functionality resolves the "conflict" between the patent laws and the Lanham Act, the Seventh Circuit seems to agree with the Tenth Circuit, since it suggested that the public should be able to use all features disclosed in T&B's patent, with functionality being ascribed no role. Thus, the Seventh Circuit appears poised to join the Tenth Circuit in concluding that a patent constitutes an absolute bar against trade dress rights, even when the trade dress is non-functional.

Contrary to the Seventh and Tenth Circuits are those courts which have held and which continue to hold that patents merely constitute *evidence* of functionality. The Ninth Circuit, for example, has stated that a patent provides one of several factors to be considered in determining functionality. *Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 516 (9th Cir. 1989); *see also Dogloo, Inc. v. Doskocil Mfg. Co.*, 893 F. Supp. 911, 918 (C.D. Cal. 1995).

The differences between the circuits on these issues are profound. Under the facts of *Thomas & Betts*, neither

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[8] The Tenth Circuit based this conclusion on the theoretical and highly improbable possibility that when a patent expires, competitors might then wish to copy non-functional features, even though there would be no competitive need or other legitimate reason to do so, given the existence of available alternative designs.

the Tenth Circuit nor the Federal Circuit (applying Eleventh Circuit law) would find T&B's expired patent to be an impediment to trade dress protection, since the claims of T&B's patent made no reference to the oval-shaped head. Other circuits, like the Ninth and the Sixth, faced with the *Vornado, Thomas & Betts* and *Elmer* cases, would likely examine the patents as evidence of functionality, but would impose no bar if non-functionality was found.

Thus, the circuits are even more at odds than they were when the present petition was filed on the relationship between the patent laws and trade dress rights under the Lanham Act. If *Vornado, Thomas & Betts* and *Elmer* are any indication, the circuits will not develop a coherent rule without guidance from the Supreme Court.

### 3. The Issue Raised By Vornado's Petition Is Unlikely To Be Resolved Satisfactorily By The Courts Of Appeal

Because the Federal Circuit has exclusive jurisdiction over actions arising under the patent laws, and because the Federal Circuit employs an unusual choice-of-law rule as to trade dress issues, *no* court of appeals having significant experience with *both* patent and trade dress issues is likely to ever reach a coherent resolution of the purported "conflict" between the patent and trade dress laws. Unlike the common situation in which a legal issue percolates among appellate courts having equal knowledge and experience on that issue, often resulting in one "better" or "prevailing" rule, the present issue may *never* be resolved satisfactorily because of these unusual jurisdictional and choice-of-law rules – unless the Supreme Court resolves it.

In 1982, Congress vested the Federal Circuit with *exclusive* jurisdiction over all appeals in actions which

include a claim of patent infringement. The Federal Circuit's jurisdiction extends to cases including both a patent claim and other claims under federal or state law, including trade dress claims. *See* 28 U.S.C. §§ 1295(a)(1) and 1338. Thus, for thirteen years, the regional circuits have had no real occasion to take up core patent issues except in the most peripheral way.

On the other hand, when the Federal Circuit decides an appeal like *Elmer* involving both patent infringement and issues which are not committed to its exclusive jurisdiction (such as trade dress infringement under the Lanham Act), it defers to what it believes is the discernible law of the regional circuit.[9] Thus, if *Elmer* had arisen in the Tenth Circuit, the Federal Circuit would have followed *Vornado* on the patent-trade dress interface issues, but would apply completely different precedents if the case arose in a different circuit (as *Elmer* did). Accordingly, in trade dress infringement cases, the Federal Circuit – the one court which deals regularly with patent law issues – will simply adhere to precedent on the patent-trade dress relationship from some other circuit, which is likely to have developed that precedent without the benefit of meaningful experience in patent law.

Congress' decision to create one appellate court to develop a coherent body of law on patent issues has thus had the unique and unintended effect of impeding the courts of appeal from separately or jointly developing a sound legal approach to issues which touch on – but are still beyond – the Federal Circuit's exclusive jurisdiction. Allowing these conflicts to go unresolved has the effect of

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[9] *See, e.g., Elmer*, 67 F.3d at 1578; *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1447 (Fed. Cir. 1993); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1129 n.5 (Fed. Cir. 1993).

undermining Congress' desire for uniformity and certainty in patent-related areas, a goal that was instrumental in leading to the creation of the Federal Circuit. *See Christianson v. Colt Industries Op. Corp.*, 486 U.S. 811, 813 (1988). Only the Supreme Court can provide guidance to all of the federal courts on the extremely important issues raised by Vornado's petition: harmonizing the patent laws and the Lanham Act so that the public is able to benefit from vigorous competition and technological advancement without being deceived by unfair competition.

**4. Resolution Of The Issue Raised By The Petition Will Impact Numerous Litigants And Countless Innocent Purchasers**

The *Vornado, Thomas & Betts* and *Elmer* cases all involved plaintiffs which at one time or another had patents covering at least some aspect of their product, and also had at least substantial claims of product configuration trade dress rights. These three cases represent just the tip of the iceberg. It is not a coincidence that innovative individuals and companies that create and market distinctive products which achieve trademark significance in the marketplace also receive patents which cover some aspect or feature of the same product. In some situations, like *Vornado*, the patent is still in force but the copier has avoided it; and in other situations like *Elmer*, the copier has arguably infringed both the patent and trade dress rights. In cases like *Thomas & Betts*, the patent was long expired and thus was no longer a concern to the copier, but the expired patent was seized upon by the copier as a purported justification for violating trade dress rights that had been built up over several decades, including twelve years after the patent's expiration.

The issues raised by the present petition are thus important to all innovators, such as the plaintiffs in *Vornado, Thomas & Betts* and *Elmer*. Rights under the Lanham Act, which manufacturers have built up by selling, advertising and standing behind quality products, are now being jeopardized by patents that expired years ago, by patents that are now in force, and perhaps even by patents that have not yet issued. Likewise, resolution of the issue is important to competitors of the innovators who wish to copy successful products as closely as possible, but only to the extent that they may do so without violating legitimate rights under the intellectual property laws.

Further, the Supreme Court has repeatedly held that a basic purpose of the patent laws is to promote public disclosure of inventions. *See, e.g., Bonito Boats*, 489 U.S. at 972 (public disclosure and use is "centerpiece" of federal patent policy); *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979). That objective is achieved by the patent laws' requirement of full and complete disclosure. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-81 (1974).[10] Decisions like *Vornado, Thomas & Betts* and *Elmer*, which threaten to forever bar protection of product configurations under the Lanham act if a feature is but part of a claimed combination or even just disclosed in a patent, cannot and do not promote full disclosure. On the contrary, they place it at risk by giving patent applicants an incentive to omit from their patent specifications details which are not essential to comply with the full disclosure requirements of the patent statutes but which,

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[10] Every patent's specification must describe the invention fully, clearly and concisely to enable those skilled in the art to practice the invention, and must set forth the best mode contemplated for carrying out the invention. 35 U.S.C. § 112, ¶ 1.

if disclosed, still enrich and advance technology. If forced to elect between trade dress rights and patents, some innovators may even choose not to seek patent protection at all. Other innovators may choose not to establish and develop trade dress rights, thus depriving the purchasing public of an important means of identifying and distinguishing competitive products from each other.

Finally, countless innocent purchasers and consumers have a significant stake in this Court's resolution of Vornado's petition. They are the victims of confusion, buying the copier's product thinking it comes from the innovator. The Tenth Circuit in *Vornado* (which had not decided a patent case in over a decade) weighed what it considered "the patent system's core goals" and "core patent principles," 58 F.3d at 1508, 1509 (Pet. App. 31a, 34a), against the principles of the Lanham Act, and resolved the perceived "conflict" against innocent purchasers, even though the district court had found that Vornado's trade dress was not functional, such that it was not essential for effective competition. The Supreme Court may well conclude that sacrificing the right of the public to be free of confusion is too great a price to pay in order to vindicate a purported "right to copy" that does not appear in any statute. While courts should promote competition, there is no reason to promote *unfair* competition.

### 5. *Vornado* and *Thomas & Betts* Raise Closely Related Questions

While T&B respectfully urges this Court to grant certiorari and decide the important issues raised by Vornado's petition, in the alternative, T&B respectfully urges this Court to hold Vornado's petition and consider it with the petition for certiorari which will be filed shortly in *Thomas & Betts*. In that petition, T&B will present the question whether, to establish trademark rights under the

Lanham Act in a product configuration having both functional and non-functional features, a manufacturer must overcome a "more stringent" standard under a "primary significance" test (as held by the Seventh Circuit, 65 F.3d at 661, and as suggested by the Tenth Circuit in *Vornado*, 58 F.3d at 1502 n.7 (Pet. App. 11a)), under which the secondary meaning must be shown to be solely attributable to non-functional features – a holding which conflicts with decisions of the Supreme Court and other circuits. T&B will urge the Supreme Court to consider whether the Seventh Circuit has improperly mixed two separate and legally distinct qualities (*i.e.*, the ability of a product configuration as a whole to indicate source to consumers, and the need of competitors to utilize legally functional features in order to compete effectively) by requiring that secondary meaning arise solely from non-functional features.

The issues raised by the *Vornado* and *Thomas & Betts* petitions are closely interrelated. The Tenth Circuit held that the reference to an asserted trade dress feature in a patent claim could be an absolute bar to trade dress protection, and stated in dicta that a "more stringent" secondary meaning standard regarding "primary significance" also was potentially fatal to Vornado's rights. The Seventh Circuit in *Thomas & Betts* held that T&B was not entitled to protection on the basis of the "primary significance" standard for secondary meaning, and indicated that the Tenth Circuit appeared to be correct regarding the impact of a patent, except that the Tenth Circuit did not go far enough. Together, the Tenth Circuit and Seventh Circuit have erected two related non-statutory barriers restricting product configuration protection under the Lanham Act. These are akin to the "special legal rule" struck down in *Qualitex*, 115 S. Ct. at 1308, and the

"superfluous" requirements found to be improper in *Two Pesos*, 112 S. Ct. at 2760.

Above and beyond the foregoing, in both cases, the Tenth and Seventh Circuits perceived – or created – conflicts based upon a misunderstanding of the functionality doctrine. As noted just months ago in *Qualitex*, "the federal courts have demonstrated that they can apply this doctrine in a careful and reasoned manner, with sensitivity to the effect on competition." 115 S. Ct. at 1306. The concern raised in *Vornado* – that trade dress rights in product configurations threaten to create perpetual patent-like impediments to competition – is seen upon close analysis as having already been resolved by considering functionality (on the basis of patents and any other relevant evidence), since functionality assures that trade dress rights may not be employed to hinder the ability to compete effectively. In *Thomas & Betts*, the Seventh Circuit's belief that secondary meaning in product configuration trade dress must be attributable solely to nonfunctional features is likewise based on a failure to appreciate the role of the functionality doctrine, and increases enormously the difficulty of establishing trade dress rights.

The *Vornado* and *Thomas & Betts* decisions together effectively eviscerate an important part of the Lanham Act and make it virtually impossible to establish rights in product configurations. Granting either petition for certiorari would be an important step in clarifying rights under the Lanham Act. Granting both would provide the Supreme Court with an opportunity to establish clear legal guidelines in this troublesome area which involves important and interrelated issues and which is rapidly spawning conflicting and erroneous decisions.

## CONCLUSION

The petition for certiorari should be granted.

Respectfully submitted,

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